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10/659,219	09/10/2003	Andre Jeutter	2001P17947WOUS	5692
7590 SIEMENS CORPORATION INTELLECTUAL PROPERTY DEPT. 170 WOOD AVENUE SOUTH ISELIN, NJ 08830			EXAMINER WONG, EDNA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/659,219
Filing Date: September 10, 2003
Appellant(s): JEUTTER ET AL.

Daniel J. Ryan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 9, 2008 appealing from the Office action mailed August 9, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims **1-2, 4-14 and 16-18** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1

lines 8-9, recite “without homogenizing a region of the substrate located laterally adjacent the homogenized region”.

Claim 13

lines 8-9, recite "without homogenizing a region of the surface of the turbine component located laterally adjacent the homogenized region".

Claim 14

lines 9-10, recite "without homogenizing a region of the substrate located laterally adjacent the homogenized region".

Applicants' specification, pages 1-5, does not mention without homogenizing a region of the substrate located laterally adjacent the homogenized region in the method. Thus, there is insufficient written description to inform a skilled artisan that applicant was in possession of the claimed invention as a whole at the time the application was filed.

However, there is sufficient written description for homogenization of the element distribution as mentioned on page 2, lines 19-20; and homogenization in the near-surface region, the layer being fused, for example at and/or under the surface, as mentioned on page 5, lines 1-2. Also, these descriptions have nothing to do with the substrate.

The Examiner has carefully considered the entire specification as originally filed, however, there is found no literal support in the specification for the limitations in amended claims 1 and 13-14. Applicants have not provided the page number and line

numbers from the specification as to where the newly amended limitations are coming from. *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984).

(10) Response to Argument

**THE EXAMINER HAS COMMITTED ERROR BY DISREGARDING THE
REQUIREMENTS OF MPEP § 2173.05(i)**

Applicants state that the substrate is represented identically in all of Figures 1 a-d thereby showing that “melting and homogenizing a region of the substrate located laterally adjacent the homogenized region” has not occurred.

In response, the structure disclosed in the specification is a “corresponding” structure in the claims only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim (MPEP § 2163.02 and § 2181(IV)). The presented negative limitation of “without homogenizing a region of the substrate located laterally adjacent the homogenized region” is not said, in the written description, to have been shown or not shown in any of the Figures.

Applicants’ original method claims were open to include the step of homogenizing a region of the substrate located laterally adjacent the homogenized region. The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps (MPEP § 2111.03). Thus, Figures 1 a-d

do not show every aspect of Applicants' method, for example, the Figures do not show the scanning of the surface treatment equipment **19** over the near-surface region of the coating layer as presented in claim **16**.

Applicants state that they rely upon Figures 1c and 1d, which are part of the originally filed specification. As such, the above claim limitation is sufficiently supported in the original disclosure and is therefore not new matter.

In response, the Examiner maintains that there is sufficient written description for homogenization of the element distribution as mentioned on page 2, lines 19-20; and homogenization in the near-surface region, the layer being fused, for example at and/or under the surface, as mentioned on page 5, lines 1-2, but that these descriptions have to do with the coating layer **13** and have nothing to do with the substrate **1**.

The terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (MPEP § 2163.02 and § 2181(IV)). There are no negative recitations disclosed in the written description, and the mere absence of a positive recitation is not a basis for an exclusion.

Applicants state that the Examiner has stated that "the structure disclosed in the specification is a 'corresponding' structure in the claims only if the specification or prosecution history clearly links or associates that structure to the function recited" citing

MPEP § 2163.02 and 2181(IV). Applicants submit that MPEP § 2181(IV) addresses Means-Plus-Function claim language as related to a 35 U.S.C. 112, sixth paragraph, rejection and since the claims at issue do not include Means-Plus-Function claim language the Examiners argument is not appropriate.

In response, MPEP § 2181(IV) addresses Means-Plus-Function claim language “***in the situation*** in which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function”.

Since the claims at issue do not include Means-Plus-Function claim language, and thus, is not a situation corresponding to Means-Plus-Function, 37 CFR 1.75(d)(1) is still applicable under MPEP § 2181(IV).

**THE EXAMINER HAS COMMITTED ERROR BY DISREGARDING THE
REQUIREMENTS OF MPEP § 2161.01(III)**

Applicants state that their specification discloses only fusing the near surface region **15** of the coating layer **13** which is distinct and separate from fusing between the coating layer **13** and the substrate material **1** as interpreted by the Examiner.

In response, Applicants' specification does not disclose ***only*** fusing the near-surface region **15** of the coating layer **13**. Thus, one of ordinary skill in the art can interpret “fusing” as carried out in the art, e.g., fusing between the coating layer and the substrate material.

THE EXAMINER HAS COMMITTED ERROR BY DISREGARDING THE
REQUIREMENTS OF MPEP §§ 2163 and 2163.04

Applicants state that the Examiner has failed to meet the requirements of MPEP § 2163.04.

In response, if the claim limitation of “without homogenizing a region of the substrate located laterally adjacent the homogenized region” is the novelty of Applicants' invention, then why was it not written about in their specification? Important terms such as “without homogenizing” and “laterally adjacent” are not written in Applicants' specification.

Furthermore, if the laterally adjacent region of the substrate **was** homogenized, then what would the Figures look like? There is no reason why it would not look like Applicants' Figs. 1c and 1d.

The claim limitation of “without homogenizing a region of the substrate located laterally adjacent the homogenized region” is not deemed apparent by the Examiner in Applicants' written description and Figs. 1c and/or 1d.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 1795

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Edna Wong/
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